

### REMARKS

The Office Action, dated October 10, 2003, has been reviewed carefully and the application amended in order to place the same in condition for allowance. Reconsideration of the rejection and allowance of the amended claims are respectfully requested on the basis of the following remarks.

#### The Invention:

The present invention provides a method for a principal to electronically locate an agent, give the agent a power of attorney, and pay the agent, and for an agent to perform a service requested by a principal.

This invention further provides a computer implemented method for a principal to electronically establish and use an agent. The method includes the following steps: the principal identifying a service requirement, the principal submitting an electronic request for service, negotiating terms by principal and agent, establishing an electronic power of attorney, the agent performing said requested service, and, the principal paying said agent.

This invention further provides a computer readable medium containing instructions for performing a method for a principal to electronically establish and use an agent. The method includes the following steps: the principal identifying a service requirement, the principal submitting an electronic request for service, negotiating terms by principal and agent, establishing an electronic power of attorney, the agent performing said requested service, and, the principal paying said agent.

This invention further provides a computer system containing instructions for performing a method for a principal to electronically establish and use an agent. The method includes the following steps: the principal identifying a service requirement, the principal submitting an electronic request for service, negotiating terms by principal and agent, establishing an electronic power of attorney, the agent performing said requested service, and, the principal paying said agent.

This invention further provides a data transmission medium containing instructions for performing a method for a principal to electronically establish and use an agent. The method includes the following steps: the principal identifying a service requirement, the principal submitting an electronic request for service, negotiating

terms by principal and agent, establishing an electronic power of attorney, the agent performing said requested service, and, the principal paying said agent.

Status of the Claims:

Claims 1-89 remain pending in this application.

Claims 33-51 stand allowed.

Claims 1-32 and 52-89 stand rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter.

Claims 52 and 71 stand rejected under 35 U.S.C. §112 as being indefinite.

Claim 1 is objected to due to a typographical error.

The drawing is objected to due to narrow margins.

Response to Rejections and Objections

Initially, Applicant notes that the Office Action Summary Sheet indicates that the period for response is three months. However, the Examiner has also set a shortened statutory period for response of two months under *Ex Parte Quayle*. Applicant believes this shortened statutory period is in error as *Quayle* sets forth the use of a shortened statutory period when all claims have been allowed, not when some claims have been allowed. Accordingly, Applicant is responding within the three-month shortened statutory period for response and has not provided the fee for a one-month extension. However, if the Examiner maintains that the two-month shortened statutory period is proper, Applicant petitions for a one-month extension and the PTO is authorized to charge any additional fees necessary or credit any overpayment to Eckert Seamans Cherin & Mellott's Deposit Account No. 02-2556.

Objections:

Claim 1 has been amended according to the Examiner's suggestion. The Drawing has been amended to provide proper margins. The new Drawing is attached to this response.

Claims 1-32 and 52-89; Rejected under 35 U.S.C. §101

Claims 1-32 and 52-89 stand rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter. Specifically, the Examiner contends that claim 1 does not result in a concrete product, claim 52 is directed to a system with instructions and claim 71 is directed to a signal. The Examiner is applying, without citing, the standard set forth in *In re Schrader*, 22 F.3d 290 (Fed. Cir. 1994). In *Schrader* the court addressed a claim that recited a method of conducting a real estate bidding process. That claim recited a computer-implemented method that included the steps of identifying adjacent lots of property and bids thereon and determining the increase in value of the property if the two adjacent lots were purchased by a single bidder. The claim concluded with a step of, "identifying in said record all of said bids corresponding to said prevailing price." Contrary to the patent owner's argument, the court found that the claim did not include a practical application. That is, the court found that all the claimed steps occurred within the computer and, contrary to patent owner's argument, the claim did not recite a practical application such as displaying the record. However, as noted in *AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1360 (Fed. Cir. 1999), in light of *State Street Bank & Trust v. Signature Financial Group*, 149 F.2d 1368 (Fed. Cir. 1998), the holding of *Schrader* is no longer "helpful." Of course, the current prevailing standard is set forth in *State Street* which holds that claim to a process that has a "useful, concrete and tangible result" meets the requirements of Section 101. See, *State Street* 149 F.3d at 1373.

In this application each independent claim recites a step of, a principal identifying a service requirement, establishing an electronic power of attorney, and having the agent perform the service, as well as a step of having the principal pay the agent. These steps recite both a process for facilitating a business transaction and a tangible result in that an agency relationship is created, a service performed and a payment is made. The creation of an agency relationship is a real world effect in that the agency exists independent of the computer. Similarly, the services performed are not limited to actions within a computer and as such, are also real world effects. Finally the step of payment indicates that money is transferred between the principal and the agent. While this transfer may occur electronically, the transfer is also a real world effect. As such, each independent claim recites a tangible result.

Accordingly, the rejections to claims 1-32 and 52-89 as set forth in paragraph 4 of the October 10, 2003 Office Action should be withdrawn.

Claims 52 and 71; Rejected under 35 U.S.C. §112

Claims 52 and 71 stand rejected under 35 U.S.C. §112 as being indefinite. More specifically, the Examiner states that, in claim 52, it is not clear if the claimed invention is a system or instructions stored on a data storage medium. Claim 52 has been amended to indicate that the instructions are stored on a computer-readable medium. With respect to claim 71, the Examiner notes that it is not clear how a data transmission medium may “contain” instructions. Applicant notes that the Examination Guidelines For Computer-Related Inventions provides the following example:

Example: AUTOMATED MANUFACTURING PLANT

Claim 13

A computer data signal embodied in a carrier wave comprising:

- a. a compression source code segment comprising . . . [recites self-documenting source code]; and
- b. an encryption source code segment comprising . . . [recites self-documenting source code].

See, <http://www.uspto.gov/web/offices/pac/dapp/pdf/compenex.pdf>. Thus, just as a “computer data signal” may be “embodied in a carrier wave,” Applicant believes a data transmission medium may “contain” computer instructions. That is, when the instructions are within the data transmission medium, the instructions have a physical form within the medium. Further, Applicant does not believe that it must be limited to a “carrier wave” as this recitation is unduly limiting. That is, new technology, such as digital light pulses, may not be considered to be a “carrier wave,” but should be considered a data transmission medium capable of giving form to the instructions.

Accordingly, the rejections to claims 52 and 71 as set forth in paragraph 6 of the October 10, 2003 Office Action should be withdrawn.

CONCLUSION

It is respectfully submitted that the rejections under 35 U.S.C. §101 as being directed toward non-statutory subject matter should be withdrawn. It is further submitted that the rejection of claims 52 and 71 under 35 U.S.C. §112 should be withdrawn. Applicant respectfully submits that the application is now in proper form for issuance of a Notice of Allowance and such action is requested at an early date.

Respectfully submitted,



David C. Jenkins

Registration No. 42,691

Eckert Seamans Cherin & Mellott, LLC

600 Grant Street, 44<sup>th</sup> Floor

Pittsburgh, PA 15219

Attorney for Applicant

(412) 566-1253